

REMARKS

This paper is being filed in response to the Notice of Non-Compliant Amendment (37 CFR 1.121) dated November 30, 2007, wherein the Examiner states the following:

A clean/clear copy is needed, as the printing of all amended portions of claim 1, both underlined additions & cross-through deletions, are fuzzy & of poor print quality, i.e. hard to read. Also, deletions of 5 or less characters, especially single character deletions, should employ double brackets, [[]]. See claims 3-4 & claim 1, lines 7 & 9.

Applicants have amended claim 1 in the manner requested by the Examiner and have placed brackets to show the deletions of 5 or less characters in claims 1, 3 and 4. No new matter has been added.

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1, 3-5, 7 and 8 are currently pending in this application. No new matter has been added by way of the present amendment. Claim 1 has been amended to incorporate the limitations of previously presented claim 2, and so as to correct certain informalities identified by the Examiner. Also, claims 2 and 6 have been cancelled and the dependency of claims 3 and 4 have been altered. Accordingly, no new matter has been added.

In view of the remarks filed on November 21, 2007 (reproduced below), Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Claim Objections

Claim 1 stands objected to due to "non-idiomatic English present". Applicants respectfully traverse.

Claim 1 has been amended to correct the informalities identified by the Examiner. Accordingly, this rejection is moot.

Reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. § 112, second paragraph

Claims 1-8 stand rejected under 35 U.S.C. 112, 2nd paragraph, for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Applicants respectfully traverse.

The Examiner asserts that the terms "binder" and "volatile" in claim 1, as well as the term "conductive" in claim 4 are vague and indefinite. The Examiner further asserts that the "scope of the amount of the "residual solvent content" remaining at the end of the 30 seconds drying time" in claim 1 is unclear.

As to the terms "residual solvent content" and "volatile", Applicants submit that claim 1 has been amended to more clearly recite the features of the present invention. Thus, these rejections are moot.

As to the term "binder", the Examiner's attention is directed to the specification at page 6, lines 18-20 which describes the function of the instant binder. Specifically, this passage recites:

"The binder serves to uniformly disperse the particulate components in the coating applied and, after drying, immobilize the components".

Thus, Applicants submit that the use of the term "binder" is appropriate, as this term has been clearly defined in Applicants' Specification.

With respect to the term "conductive," the Examiner's attention is directed to the specification at page 11, lines 5-16; page 16, line 7 to page 17, line 9; and Figure 1. The cited portions of the Specification clearly define the term "conductive" and further distinguish a "conductive heater" from a "radiant heater."

Additionally, Applicants submit that the terms "binder" and "conductive" are well known in the art, and one of ordinary skill in the art would readily understand their meaning. Under U.S. law, the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification" (see MPEP 2173.02). Applicants respectfully submit that one skilled in the art would clearly understand what is claimed when the claims are read in light of Applicants' Specification, particularly the passages cited above.

Reconsideration and withdrawal of this rejection are thus respectfully requested.

"Matters of Scope"

The Examiner also discusses "a matter of scope...with respect to claim 2".

Applicants respectfully submit that claim 2 has been cancelled by way of the present amendment. Also, the subject matter of claim 2, which is now recited in claim 1, has been clarified to avoid this issue. Accordingly, the issues identified by the Examiner are moot.

Issues under 35 U.S.C. §102/103(a)

Claims 1-2 and 5-6 stand rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Arter et al. (U.S. 4,365,423) (hereinafter Arter '423). Applicants respectfully traverse.

The Examiner asserts that Arter '423 teaches a process of drying a sheet material that has been coated with a layer or layers of liquid coating composition. The Examiner further asserts that the specifically claimed cellulose triacetate is encompassed by Arter '423's generic cellulose ester disclosure. Additionally, the Examiner asserts that Arter '423's teaching that the weight percentage of solids in the coating composition can be as high as 90% or more "will automatically meet the claimed 'solvent content...30% or less based on the binder'".

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993). To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present". *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The present invention is directed, *inter alia*, to a method of drying a liquid coating composition comprising the steps of coating a base film containing cellulose triacetate with a liquid coating composition comprising a solvent and a binder, and drying the coated base film,

wherein the step of drying the coated base film starts within 10 seconds of coating, wherein a residual amount of solvent remains on the coated base film after drying, wherein the residual solvent to binder ratio is reduced to 30% or less within 30 seconds of coating, and wherein the step of drying the coated base film comprises heating the side of the base film opposite the coated side.

Arter '423 teaches controlling the rate of solvent evaporation from the coating film so as to avoid coating unevenness. To achieve this objective, Arter '423 teaches disposing a flat metal plate or screen near the coated surface to avoid disturbances during coating. However, contrary to the Examiner's assertion, Arter '423 does not teach at least controlling the residual solvent to binder ratio so that it is reduced to 30% or less within 30 seconds of coating, as required by present claim 1.

Clearly, Arter '423 fails to implicitly or explicitly teach each and every limitation of the present invention, as required by 35 U.S.C. 102, and thus fails to anticipate the same. Accordingly, this rejection is improper and should be withdrawn.

Furthermore, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted

a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the "teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicants submit that one skilled in the art would not have been motivated to modify the teachings of Arter '423 as proposed by the Examiner. Furthermore, Applicants submit that the unexpected results obtained by Applicants rebut any *prima facie* case of obviousness allegedly established by the Examiner.

For purposes of illustration and not limitation, the Examiner's attention is directed to pages 19-25 of the present Specification. As evidenced by the Examples and Comparative Examples described therein, significant improvements on the properties of a film are obtained based on the timing of the drying (see, for instance, Inventive Example 1 and Comparative Example 2).

Evidently, the cited references, alone or in combination, fail to teach or suggest every limitation of the instant invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Issues Under 35 U.S.C. §103(a)

Claims 3-4 and 7-8 stand rejected under 35 U.S.C. 103(a) as being obvious over Arter '423 in view of Maehashi Tatsuichi et al. (JP 10-312054) (hereinafter Tatsuichi '054). Additionally, claims 3 and 7 stand rejected under 35 U.S.C. 103(a) as being obvious over Arter '423 in view of Dessauer et al. (U.S. 3,909,328) (hereinafter Dessauer '328) or Cescon et al. (U.S. 3,615,454) (hereinafter Cescon '454). Applicants respectfully traverse.

Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. As discussed above, Arter '423 fails to teach or suggest a method of drying a liquid coating composition as presently claimed. The secondary references cited by the Examiner fail to cure these deficiencies.

Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Marc S. Weiner, Reg. No. 32,181 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: DEC 31 2007

Respectfully submitted,

By 

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

DOCKETED
Response
123007

**Notice of Non-Compliant
Amendment (37 CFR 1.121)**

Application No.

10/775,248

Examiner

Marianne L. Padgett

Applicant(s)

NOJO ET AL.

Art Unit

1792

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

The amendment document filed on 21 November 2007 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121 or 1.4. In order for the amendment document to be compliant, correction of the following item(s) is required.

THE FOLLOWING MARKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

- ☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
 - ☐ B. New paragraph(s) should not be underlined.
 - ☐ C. Other _____.
- ☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
 - ☐ B. Other _____.
- ☐ 3. Amendments to the drawings:
- ☐ A. The drawings are not properly identified in the top margin as "Replacement Sheet," "New Sheet," or "Annotated Sheet" as required by 37 CFR 1.121(d).
 - ☐ B. The practice of submitting proposed drawing correction has been eliminated. Replacement drawings showing amended figures, without markings, in compliance with 37 CFR 1.84 are required.
 - ☐ C. Other _____.
- ☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
 - ☐ B. The listing of claims does not include the text of all pending claims (including withdrawn claims)
 - ☐ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. Note: the status of every claim must be indicated after its claim number by using one of the following status identifiers: (Original), (Currently amended), (Canceled), (Previously presented), (New), (Not entered), (Withdrawn) and (Withdrawn-currently amended).
 - ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
 - ☒ E. Other: See Continuation Sheet.
- ☐ 5. Other (e.g., the amendment is unsigned or not signed in accordance with 37 CFR 1.4):

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP § 714.

TIME PERIODS FOR FILING A REPLY TO THIS NOTICE:

1. Applicant is given **no new time period** if the non-compliant amendment is an after-final amendment or an amendment filed after allowance. If applicant wishes to resubmit the non-compliant after-final amendment with corrections, the **entire corrected amendment must be resubmitted.**
2. Applicant is given **one month**, or thirty (30) days, whichever is longer, from the mail date of this notice to supply the correction, if the non-compliant amendment is one of the following: a preliminary amendment, a non-final amendment (including a submission for a request for continued examination (RCE) under 37 CFR 1.114), a supplemental amendment filed within a suspension period under 37 CFR 1.103(a) or (c), and an amendment filed in response to a Quayle action. If any of above boxes 1. to 4. are checked, the correction required is only the **corrected section** of the non-compliant amendment in compliance with 37 CFR 1.121.

Extensions of time are available under 37 CFR 1.136(a) only if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action.

Failure to timely respond to this notice will result in:

Abandonment of the application if the non-compliant amendment is a non-final amendment or an amendment filed in response to a Quayle action; or

Non-entry of the amendment if the non-compliant amendment is a preliminary amendment or supplemental amendment.

Legal Instruments Examiner (LIE), if applicable

Telephone No.

U.S. Patent and Trademark Office

Part of Paper No. 20071126

MARIANNE PADGETT
PRIMARY EXAMINER

MARIANNE PADGETT
PRIMARY EXAMINER

Continuation of 4(e) Other: A clean/clear copy is needed, as the printing of all amended portions of claim 1, both underlined additions & cross-through deletions, are fuzzy & of poor print quality, ie hard to read. Also, deletions of 5 or less characters, especially single character deletions, should employ double brackets, [[]]. See claims 3-4 & claim 1, lines 7 & 9.

A handwritten signature in black ink, appearing to be 'MJP', is centered on the page below the text.